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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,446	02/11/2002	Andrew R. Jamieson	3139-011867	4487

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EXAMINER

KIZILKAYA, MICHELLE R

ART UNIT PAPER NUMBER

1661

DATE MAILED: 08/11/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	10/073,446	Applicant(s)	JAMIESON
Examiner	KIZILKAYA	Group Art Unit	1661

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

Responsive to communication(s) filed on papers filed 7/14/03

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

### Disposition of Claims

Claim(s) 1 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

## Office Action Summary

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**DETAILED ACTION**

**Rejection of the Disclosure**

**35 U.S.C. 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim Rejection**

**35 U.S.C. § 102**

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by a printed publication based on the Plant breeders Right document 97-998.

**35 U.S.C. 102**

The claimed Strawberry variety 'Cabot' is described in Breeder's Right grant number 0462 granted in Canada on June 6, 2002. The publication of the grant took place on August 5, 1998 and the denomination was proposed on August 5, 1997. The application filing date of March 13, 1997 was published on April 30, 1997 more than one year prior to the filing date of the instant application.

The published application, grant and denomination are each "printed publications" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128.

For example, UPOV publishes the application number, grant number, date of publication, species of plant, and variety denomination for PBR certificates, and copies of the each grant are

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obtainable in Canada. All documents relating to the application are open for public inspection. Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992)(“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

While the publications cited above disclosed the claimed plant variety, the question remained as to whether the references are enabling. If the plant was publicly available, then the published application, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. Based on applicant’s response the instant plant was in fact publicly available is limited more than one year prior to the U.S. filing.

More specifically, applicant admits the instant plant was first available to the public in Canada after June 2, 1998. Although applicant insists said rejection is wholly inappropriate, applicant’s response is non-persuasive as the argument presented fails to prove that the instant

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plant had not been described in a printed publication in the U.S. or other country by another based on the assertion that the invention was discovered well before the publication date. The issue instead is whether the availability of the plant coupled with the publication were sufficient to put the plant in the public domain more than one year prior to filing in the U.S. Based on applicant's admission such availability did in fact occur more than one year prior to the U.S. filing. While applicant asserts such availability took place only in Canada, 35 USC 102(b) still applies as the instant plant had been both published and available and therefore enabled. There is no geographic component to enablement. A reference is enabling if it allows anyone, anywhere, to make and use the invention.

#### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michelle R. Kizilkaya whose telephone number is (703) 308-4324. The Examiner can normally be reached Monday through Friday from 9:00 am to 5:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

M. R. Kizilkaya / mrk



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